

Remarks

Following the above amendments, claims 1-3, 6-9, 12-18, and 20 are pending in this application. The examiner has rejected claims 1-3, 8, 9, 14-18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent NO. 6,584,559 to Huh et al. The examiner also has rejected claims 4-5, 10-11, and 19 under 35 U.S.C. § 103 as being obvious over Huh.

A. Obviousness Rejections of Independent Claims 1, 8, and 14

The examiner has rejected claims 4-5, 10-11, and 19 as being obvious over Huh. Each of these claims is directed to a requirement that the device of the claim is a hard drive and that the storage location of the replacement firmware is a storage location on the hard drive. The examiner has recognized that this disclosure is not present in Huh. The examiner does not cite a second reference in addition to Huh. Rather, the examiner has provided his opinion that it would have been obvious for someone to use the method of Huh in a hard disk drive.

To the extent that the examiner is making a finding premised on common knowledge or well known prior art, the applicants hereby traverse such finding pursuant to Manual of Patent Examining Procedure § 2143.01(c), which provides that the examiner cannot stand on a rejection of common knowledge or well known prior art in the absence of documentary evidence of the same. As such, applicants respectfully request that the examiner come forward with documentary evidence demonstrating that it would have been obvious to use the method of Huh in a hard disk drive.

Further, Huh does not disclose or suggest all of the elements of the claimed invention. Each of the independent claims of the application has been amended to specify that the replacement firmware is stored on the hard disk drive, and that the hard disk drive is separate from the storage location of the existing firmware. This limitation is advantageous because it

logically and physically separates the process of downloading firmware from the process of substituting the replacement firmware for the existing firmware. This logical and physical separation is beneficial in that it reduces the risk of overwriting the firmware during the download of the replacement firmware and thereby increases the integrity of the firmware replacement process.

In contrast, Huh discloses a system in which the replacement firmware and the existing firmware are saved to the same storage space. Both the replacement firmware (54) and the existing firmware (46) of Huh are stored in a single storage device (26). This feature is plainly distinct from the requirement of each of the amended claims that the replacement firmware of the hard drive be downloaded or saved to a location that is separate from the storage location of the existing firmware. In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Here, the claim elements of saving the replacement firmware to a storage location that is separate from the storage location of the existing firmware is not shown in Huh. Applicants respectfully submit that the rejection of independent claims 1, 8, and 14 be withdrawn and these claims be passed to issuance.

B. Dependent Claims 2, 3, 6, 7, 9, 12, 13, 18, and 20

Applicants will not discuss dependent claims 2, 3, 6, 7, 9, 12, 13, 18, and 20 herein as these claims depend from otherwise allowable base claims. Applicants respectfully submit that the rejection of dependent claims 2, 3, 6, 7, 9, 12, 13, 18, and 20 should be withdrawn and that these claims should be passed to issuance.

Conclusion

Applicants respectfully submit that the rejection of claims 1-3, 6-9, 12-18, and 20 should be withdrawn and that these claims should be passed to issuance.

Respectfully submitted,



Roger Fulghum
Registration No. 39,678

Baker Botts L.L.P.
910 Louisiana St.
One Shell Plaza
Houston, Texas 77002-4995
(713) 229-1707

Baker Botts Docket Number: 016295.1532

Date: August 28, 2006